



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/837,884 | 04/18/2001 | M. Russel Merchen | 124521-1000 | 8347 |

7590 06/17/2005

Gardere Wynne Sewell, LLP
3000 Thanksgiving Tower
1601 Elm Street Suite 3000
Dallas, TX 75201-4767

| |
|----------|
| EXAMINER |
|----------|

DADA, BEEMNET W

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2135

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,884

Applicant(s)

MERCHEN ET AL.

Examiner

Beemnet W. Dada

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/24/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in reply to an amendment filed on March 24, 2005. Claims 1, 9, 11, 17, 25, 33 and 41 have been amended. Claims 1-41 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US Patent 6,385,728 in view of Padgett et al US Patent 6,535,978 B1 (hereinafter Padgett).

4. As per claims, 1, 17, and 33, DeBry discloses means of authorizing electronic data transfer (abstract) comprising:

receiving an authentication request containing a digital certificate from a requesting device via a communication link (506, fig 5 and col 8 ln 50-53)

determining whether the digital certificate is valid (507, fig 5 and col 8 ln 53-63);

creating an authentication response (508, fig 5) denying authentication request when the digital certificate is not valid, or approving the authentication request when the digital certificate is valid (col 8 ln 5860);

sending the authentication response to the requesting device via the communication link (508, fig 5, col 8 ln 58-65);

storing information about the electronic data transfer, the digital -certificate and at least a portion of the authentication response-(col 8 ln 60 - col 9 ln 4; the user must forward such data to a printer for obtaining the file, thus such information storing is inherent to the teachings of DeBry). DeBry is silent on securely storing information such that non-repudiation of the electronic data transfer may be established. It is well known in the art to store transaction information and digital certificate such that non-repudiation of electronic data transfer may be established. For example, Padgett teaches Digital Signature authentication method, including securely storing transaction, authentication and digital certificate information such that non-repudiation of the transaction may be established [column 6 line 53-column 7, line 3, column 7, lines 65- column 8, lines 12 and column 8, lines 45-54]. Both DeBry and Padgett teach authentication using digital certificates. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to employ the teachings of Padgett within the system of DeBry in order to further enhance the security of the system.

5. As per claims 2, 18, and 34, DeBry further discloses wherein the authentication request and the authentication response are transmitted via encrypted message (secure environment, col 2 ln 34-45 and col 8 ln 40-49).

6. As per claims 4, 20, and 36, DeBry further discloses wherein the authentication response includes a date/time stamp (col 7 ln 28-30).

7. As per claims 5, 21, and 37, DeBry further discloses wherein the digital receipt includes a digital receipt (will call certificate (col 8 ln 50-65)).

8. As per claims 6, 22, and 38, DeBry further discloses wherein the digital receipt includes an identification of an originator of the electronic data transfer (user ID, col 7 ln 37-38).

9. As per claims 7, 23, and 39, As per claims 4, 20, and 36, DeBry further discloses wherein the digital receipt includes an identification of a recipient of the electronic data transfer (printer ID, col 7 ln 39-40).

10. As per claims 8, 24, and 40, DeBry further discloses wherein the information about the electronic data transfer includes an electronic document (a document printed, col 5 ln 51-53).

11. As per claims, 9, 25, and 41, DeBry discloses means of authorizing electronic data transfer (abstract) comprising: receiving an authentication request containing a digital certificate and information about the electronic data transfer from a requesting device via a communication link (506, fig 5 and col 8 ln 50-53; such information about the electronic data transfer must be included to specify the correct document to be obtained) determining whether the digital certificate is valid (507, fig 5 and col 8 ln 53-63); creating an authentication response (508, fig 5) denying authentication request when the digital certificate is not valid, or approving the authentication request when the digital certificate is valid (col 8 ln 5860); sending the authentication response to the requesting device via the communication link (508, fig 5, col 8 ln 58-65); creating a digital receipt for the electronic data transfer when the digital certificate is valid (will call certificate; col 8 ln 58-60)

storing information about the electronic data transfer, the digital certificate and at least a portion of the authentication response (col 8 in 6col 9 ln 4; the user must forward such data to a printer for obtaining the file, thus such information storing is inherent to the teachings of DeBry).

Debry is silent on securely storing information such that non-repudiation of the electronic data transfer may be established. However, It is well known in the art to store transaction information and digital certificate such that non-repudiation of electronic data transfer may be established. For example, Padgett teaches Digital Signature authentication method, including securely storing transaction, authentication and digital certificate information such that non-repudiation of the transaction may be established [column 6 line 53-column 7, line 3, column 7, lines 65-column 8, lines 12 and column 8, lines 45-54]. Both Debry and Padgett teach authentication using digital certificates. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to employ the teachings of Padgett within the system of Debry in order to further enhance security of the system.

12. Claims 10, 26, and 42, recite similar limitations as described in claims 2, 18, and 34 as described above and are rejected under the same rationale.

13. Claims 12, 28, and 44, recite similar limitations as described in claims 4, 20, and 36 as described above and are rejected under the same rationale.

14. Claims 13, 29, and 45, recite similar limitations as described in claims 6, 22, and 38 as described above and are rejected under the same rationale.

15. Claims 14, 30, and 46, recite similar limitations as described in claims 7, 23, and 39 as described above and are rejected under the same rationale.

Art Unit: 2135

16. As per claims 15, 31, and 47, DeBry-Padgett discloses the claimed limitations as described above (see claim 9). As for where in the digital receipt includes an action taken relating to the electronic transfer, DeBry further discloses that such a receipt is used a means of validating printing of a document (col 7 in 7-20 and col 8 in 58-65), and thus an action (validation of printing) taken relating to the electronic transfer.

17. Claims 16, 32, and 48, recite similar limitations as described in claims 8, 24, and 40 as described above and are rejected under the same rationale.

18. As per claims, 3, 19, and 35, DeBry further discloses an alternative embodiment comprising of determining whether a digital certificate is valid comprising; sending a validation request for the digital certificate to a validation authority (col 9 in 15-20). As for receiving a validation response from the validation authority indicating whether or not the digital certificate is valid, DeBry further discloses that the server using a validation authority to authenticate the certificate (col 9 in 15-19). Such a validation response is inherent to such network communications involving authentication of a digital certificate by a validation authority.

19. Claims 11, 27, and 43 recite the same limitations as described in claims 3, 19, and 35 above and are rejected under the same rationale.

Response to Arguments

20. Applicant's arguments with respect to claim 1-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/837,884
Art Unit: 2135

Page 8

Beemnet Dada

June 10, 2005

H.S. S
Primary Examiner
AU 2135